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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,402

Applicant(s)

TRACY ET AL.

Examiner

Thomas A. Dixon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23 is/are pending in the application.
- 4a) Of the above claim(s) 23-28, 30-35, 37, 38 and 40-45 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 and 38 is/are allowed.
- 6) ☒ Claim(s) 23-28, 31-35, 37, 40-43, 45 is/are rejected.
- 7) ☒ Claim(s) 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 23-28, 30-35, 37-45 are pending in the application, claims 1-22, 29 and 36 have been cancelled.
2. A careful reading of the claims, allowance conference and review of the references necessitated the rejections below.

The data added to claim 23 has been given no weight as it is not used.

Terminal Disclaimer

3. The terminal disclaimer filed on 8/11/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 5,979,757 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Interpretation

4. Claims directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of claim 40, including a communication system, a kiosk, a self-scanning system and a plurality of checkout lanes are disclosed in Roach et al (5,310,997) as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

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Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Roach et al (5,310,997).

As per Claim 40.

Roach et al ('997) discloses:

a communications system, see figure 2 (32, 34, RF);

a kiosk (220A,B,C)

a self-scanning system see (18);

a plurality of checkout lanes, see (18, 16).

As per Claim 41,42.

The limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 23-24, 27-28, 35, 37, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco (6,047,614) in view of PC EXPO or Internet Key to Link Key Services.

As per Claim 23.

Bianco ('614) discloses:

a) generating a list of desired items at a location remote from the shopping facility, see column 3, lines 14-43;

b) transmitting the list to a first computer, see column 3, lines 44-52;

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c) storing the list in a user data file on the first computer, see column 3, lines 33-35 and column 3, lines 57-52 and column 4, lines 49-67;

d) retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer, see column 3, lines 44-50;

e) delivering the list to the user at the shopping facility in a user perceptible format, see column 3, lines 52-57.

Bianco further discloses transmitting a list via modem, see column 4, lines 26-35 but does not disclose use of email for communication.

PC EXPO and Internet Key to Link Key Services teach that email is old and well known and the receiving of email at a kiosk is old and well known for the benefit of using a well known form of electronic communication.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email as taught by PC EXPO and Internet Key to Link Key Services in the invention of Bianco for the benefit of using a well known form of electronic communication.

As per Claim 24.

Bianco ('614) further discloses first computer is a user computer and the list is communicated through electronic communications means, see column 3, lines 14-57 and column 4, lines 26-40.

As per Claim 27.

Bianco ('614) further discloses marketing messages, see column 4, lines 1-8.

As per Claim 28.

Bianco ('614) further discloses marketing messages are selected from the group comprising a discount coupon and competitive product availability, see column 4, lines 1-8.

As per Claim 35.

Bianco ('614) further discloses creating a list from previously purchased items, see column 3, lines 29-34.

As per Claim 37.

Bianco ('614) further discloses the format is one of text data, audio data, see column 3, lines 52-57 and column 4, lines 30-35.

As per Claim 43.

Bianco ('614) discloses:

means for generating a list of desired items at a location remote from the shopping facility, see column 3, lines 14-43;

means for transmitting the list to a first computer, see column 3, lines 44-52;

means for storing the list in a user data file on the first computer, see column 3, lines 33-35 and column 3, lines 57-52 and column 4, lines 49-67;

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means for retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer, see column 3, lines 44-50;

means for communicating the list to the user at the shopping facility in a user perceptible format, see column 3, lines 52-57.

Bianco further discloses transmitting a list via modem, see column 4, lines 26-35 but does not disclose use of email for communication.

PC EXPO and Internet Key to Link Key Services teach that email is old and well known and the receiving of email at a kiosk is old and well known for the benefit of using a well known form of electronic communication.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email as taught by PC EXPO and Internet Key to Link Key Services in the invention of Bianco for the benefit of using a well known form of electronic communication.

7. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco (6,047,614) in view of PC EXPO or Internet Key to Link Key Services further in view of Roach et al (6,310,977).

As per Claim 25.

Bianco ('614) further discloses giving advice to shoppers, see column 4, lines 1-8 and 59-67 and a link to the store's inventory system, see column 3, lines 47-52, but does not disclose delivering a message regarding items which are out of stock.

Roach et al ('977) teaches checking for stock and offering comparable items if out of stock, see figure 3a (330, 332) for the benefit of making a sale even though the item of interest is out of stock.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to give a message identifying items out of stock and giving alternatives as taught by Roach et al ('997) for the benefit of making a sale even though the item of interest is out of stock.

As per Claim 26.

Bianco ('614) further discloses identifying alternate products, see column 4, lines 64-67.

8. Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco (6,047,614) in view of PC EXPO or Internet Key to Link Key Services further in view of Gordon (5,608,786).

As per Claim 31.

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Bianco ('614) further discloses preference information from the user, see column 4, lines 49-62, but does not disclose automatically associating the user data file with a predetermined email address such that the email is delivered via the e-mail address.

Gordon teaches a system which associates email to a specific user data file, see column 3, lines 36-41 for the benefit of allowing the user to always be contacted.

Therefore, it would have been obvious to one of ordinary skill in the art, at the with the data file time the invention was made to automatically associate a predetermined email address with a user file for the benefit of allowing the user to always be contacted.

As per Claim 32.

Bianco ('614) does not disclose indicating to the user that the email is present.

Official Notice is taken that it is old and well known in the computer arts to inform computer users that they have mail, for example, Microsoft's Email provides a popup box to say you have mail, and America Online had a verbal "You've Got Mail" indicator for the benefit of alerting computer user's to their mail.

Gordon teaches a system which alerts users to email received, see column 3, lines 36-41 for the benefit of allowing the user to always be contacted.

Therefore, it would have been obvious to one of ordinary skill in the art, at the with the data file time the invention was made to automatically alert a user of email for the benefit of allowing the user to always be contacted.

As per Claim 33.

Bianco ('614) does not disclose indicating to the user that the email is present at the portable terminal assigned to the user at the shopping facility.

Official Notice is taken that it is old and well known in the computer arts to inform computer users that they have mail, for example, Microsoft's Email provides a popup box to say you have mail, and America Online had a verbal "You've Got Mail" indicator for the benefit of alerting computer user's to their mail.

Gordon teaches a system which alerts users to email received a portable device, see column 3, lines 36-41 for the benefit of allowing the user to always be contacted.

Therefore, it would have been obvious to one of ordinary skill in the art, at the with the data file time the invention was made to automatically alert a user of email for the benefit of allowing the user to always be contacted.

As per Claim 34.

Bianco ('614) does not disclose the user selects an option of the portable terminal to display email.

Gordon teaches a user selects an option to display email on a portable terminal, see column 3, lines 36-41 for the benefit of allowing the user to always be contacted.

Therefore, it would have been obvious to one of ordinary skill in the art, at the with the data file time the invention was made to automatically alert a user of email for the benefit of allowing the user to always be contacted.

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9. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco (6,047,614) in view of PC EXPO or Internet Key to Link Key Services further in view of Official Notice.

As per Claim 45.

Bianco ('614) further discloses items held for a customer for pickup, see column 4, lines 26-40, but does not disclose providing a container with a unique identification, such that one or more of the desired items are purchased by the user are placed in the container; and

generating a list of the purchased items by scanning the one or more desired items placed in the container, which unique identification and the list of purchased items are at least one of stored locally at the shopping facility or forwarded to the user via email.

Official notice is taken that shopping carts with numbers on the front of them are old and well known in the shopping arts for the benefit of telling one customers cart from another at the pickup lane, it is further old and well known for the checker to input the cart number and to print the cart number on the receipt for the benefit of either remembering the cart number upon returning to the pickup lane in the car or passing the receipt to the grocery bag boy to help load the car.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide a container with a unique identification for the benefit of telling one customer's cart from another at the pickup lane and further for the checker to input the cart number and to print the cart number on the receipt for the benefit of either remembering the cart number upon returning to the pickup lane in the car or passing the receipt to the grocery bag boy to help load the car.

Allowable Subject Matter

10. Claims 30, 38 are allowable.

11. Claim 44 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Bianco ('614) further discloses a portable shopping terminal capable of scanning items, see column 3, lines 29-34, but does not disclose the list is communicated to the portable shopping terminal.

12. The following is an examiner's statement of reasons for allowability.

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As per Claim 30.

The prior art of record, specifically, Roach ('997) or Bianco (614) or Ruppert et al (5,424,524) do not disclose or fairly teach:

at least one kiosk that generates a customer list of items to be purchased by each of a plurality of customers; and

a shopping list distribution communication device that delivers the customer list presented on the kiosk to the portable shopping terminal corresponding to the customer using the self scanning system.

As per Claim 38.

The prior art of record, specifically, Roach ('997) or Bianco (614) or Ruppert et al (5,424,524) do not disclose or fairly teach:

transmitting from a store computer to a home computing device a list of previously purchased items, the list of previously purchased items is generated at the shopping facility based on purchase history of the user;

transmitting the customer shopping list via an e-mail message to a store computer of the shopping facility;

storing the customer shopping list in a user data file on the store computer;

in response to a user request, transmitting the customer shopping list from the user data file to a kiosk for presentation to the user; and

thereafter, transmitting the customer shopping list to a portable terminal device of the user in a user perceptible format.

The claims that depend from the above allowable claims are allowable for the same reasons.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner
Art Unit 3639

October 05